

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHEDRICK D. JONES

Appeal No. 1999-0117
Application 08/702,948¹

ON BRIEF

Before ABRAMS, STAAB and NASE, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 6-15, 20 and 22. Claims 1-5 have been withdrawn from further consideration pursuant to 37 CFR

¹ Application for patent filed August 26, 1996. According to the appellant, the application is a continuation-in-part of Application 08/614,494, filed March 13, 1996; which is a continuation of Application 08/290,610, filed August 15, 1994, abandoned. We note that in the '494 application, it is said to be a division of the '610 application. This inconsistency is deserving of correction.

Appeal No. 1999-0117
Application 08/702,948

§ 1.142(b) as not being readable on the elected invention. Claims 16-19 and 21, the only other claims remaining in the application, have been allowed. On page 1 of the brief under the heading "Status of Claims," appellant states that "Claims 20 and 22 are not being appealed." Accordingly, the appeal as to these claims is dismissed, leaving for our consideration only the rejection of claims 6-15.

This appeal is related to Appeal No. 1998-2827 in appellant's copending Application 08/614,494 in that the claimed subject matter in both appeals relates to a bone implant device.

Appellant's invention pertains to a dental or skeletal implant for attaching prosthetic devices to bone tissue. Two embodiments of appellant's implant are disclosed, namely, the embodiment of Figure 5 and the embodiment of Figure 6. Common to each embodiment is a main section (generally, the lower portion of the implant as shown in Figures 5 and 6) which is to be implanted in bone tissue, and a terminal portion (generally, the reduced diameter upper portion of the implant as shown in Figures 5 and 6) which is for attaching a prosthetic device. The main section of each embodiment includes a helical groove 53 to aid in distributing bone-fragment crumbs throughout the main section of the implant (specification, page 8, lines 3-6), a plurality of

diametrical holes 57 to provide avenues for bone tissue growth after installation (specification, page 8, lines 7-11), and a tapered section 55 at the distal end to allow easy entry into a preformed hole in the bone tissue (specification, page 8, lines 1-2). The Figure 5 embodiment additionally includes screw threads on the surface of the main section to permit the implant to cut its own threads in bone tissue when it is installed (specification, page 7, lines 19-21). The Figure 6 embodiment is similar in all respects to the Figure 5 implant except that it does not have screw threads and has in addition a coaxial hole 67 which connects to hole 57 (specification, page 7, lines 17-18). Claim 6, a copy of which appears in an appendix to appellant's brief, is illustrative of the appealed subject matter.

No references are relied upon by the examiner in support of the appealed rejection.

Claims 6-15 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a disclosure that failed to provide descriptive support for the claimed invention.

Two limitations added to the claims during prosecution to distinguish over the prior art are considered by the examiner as lacking descriptive support in the application as originally filed. The first questioned limitation calls for "the contact

between the distal plane^[2] and the main section being [#1] a single point, [#2] substantial portions of a concentric circle, [#3] substantial portions of a region bounded by a concentric circle, or [#4] substantial portions of a region bounded by two concentric circles," and is found in both independent claim 6 and independent claim 15. The second questioned limitation sets forth that the at least one helical channel "[has] closed ends," and is found only in independent claim 6. We shall treat each of these limitations separately.

The Distal End Configuration Limitation

Considering first the limitation describing the distal end of the implant as having one of the configurations #1 through #4 as denoted above, the examiner considers that appellant's disclosure does not provide descriptive support for the contact between the distal plane and the main section being "[#3] substantial portions of a region bounded by a concentric circle,

²The term "distal plane" is described in other portions of claims 6 and 15 as being perpendicular to the axis of the implant device and in contact with the main section. In that the distal end of the implant device is the lowermost end of the implant device as illustrated in Figures 5 and 6, it reasonably appears that the "distal plane" is that plane which is perpendicular to the axis of the implant and which intersects the lowermost end of the implant device, and we so interpret the term "distal plane" as used in the appealed claims.

or [#4] substantial portions of a region bounded by two concentric circles.”³

Appellant offers the following analysis and argument for the claim language in question:

What the boldface limitations do is include the applicant's embodiments of Figs. 5 and 6 (and reasonable variations thereof) and exclude the Vlassis implant.⁴ Specifically, applicant's Fig. 5 embodiment is characterized by [#1] **the contact between the distal plane and the main section being a single point** and applicant's Fig. 6 embodiment is characterized by [#2] **the contact between the distal plane and the main section being substantial portions of a concentric circle**. If the end of the Fig.-5 embodiment were flat rather than rounded, then the embodiment would be characterized by [#3] **the contact between the distal plane and the main section being substantial portions of a region bounded by a concentric circle**. If the end of the Fig.-6 embodiment were flat rather than rounded, then the embodiment would be characterized by [#4] **the contact between the distal plane and the main section being substantial portions of a region bounded by two concentric circles**. The use of the word "substantial" in the claim language provides protection against infringers who might attempt to design around the claim by, for example, placing radial grooves at the end of an implant that is otherwise a copy of applicant's invention. [Brief, paragraph spanning pages 16 and 17.]

³ Implicit in the above is the examiner's determination that appellant's disclosure does provides descriptive support for end configurations #1 and #2, a determination with which we do not necessarily agree.

⁴Vlassis is a patent applied by the examiner against the claims at one point during the prosecution.

Appeal No. 1999-0117
Application 08/702,948

With respect to the description requirement found in the first paragraph of 35 U.S.C. § 112,

[t]he test for determining compliance . . . is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. The content of the drawings may also be considered in determining compliance with the written description requirement.

In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983) (citations omitted). That a person skilled in the art might realize from a reading of appellant's disclosure that a particular structural configuration is *possible* in the practice of appellant's invention is not a sufficient indication to that person that that configuration is part of appellant's invention. *In re Barker*, 559 F.2d 588, 591, 194 USPQ 470, 474 (CCPA 1977); *In re Winkhaus*, 527 F.2d 637, 640, 188 USPQ 129, 131 (CCPA 1975).

Having considered the record before us in light of the respective positions of the examiner and appellant, we conclude that the examiner's determination that appellant's disclosure does not provide 35 U.S.C. § 112, first paragraph, descriptive support for configurations #3 and #4 is well founded. Our reasons follow.

To begin, as is apparent from the above cited case law, the test for compliance with the written description requirement is not whether the claim language in question is a "reasonable variation" of something disclosed in the application, as appellant apparently believes. Here, the end configurations #3 and #4 are simply not part of the original disclosure. Appellant tacitly admits as much in arguing on page 16 of the brief that *if* the end of the Figure 5 embodiment or Figure 6 embodiment were to be made flat, *then* the #3 and #4 end configurations, respectively, would result. As to appellant's argument on page 9, lines 5-18 of the brief, the obvious flaw in this argument is that it incorrectly and inappropriately infers from the circumstance that the examiner did not initially enter a 35 U.S.C. § 112, first paragraph, rejection against claim 6 that the examiner found support in appellant's specification and drawings for any and all end configurations within the broad scope of that claim 6. This is simply not the case, and to conclude otherwise is simply wrong. Concerning the cases cited on page 17 of the brief, these cases are inapposite to the descriptive support issues raised in this appeal in that they were particularly

concerned with the 35 U.S.C. § 112, first paragraph, requirements imposed by § 112, sixth paragraph, claim limitations. In this regard, as has been noted many times by the courts, the question of how close the original disclosure must come to the later claimed invention in order to comply with the description requirement must be determined on a case by case basis. *See, for example, In re Wilder*, 736 F.2d 1516, 1520, 222 USPQ 369, 372 (Fed. Cir. 1984). As to the statement on page 18 of the brief to the effect that the disclosure of Figure 5 and 6 embodiments is also a disclosure of any other distal-end shapes which allow for easy entry of the implant into a predrilled hole, we simply disagree with appellant on this point.

The Helical Channel "Closed End" Limitation

The examiner also considers that appellant's disclosure fails to provide descriptive support for the requirement of claim 6 that the helical channel has "closed ends." Here again, we must agree with the examiner that the limitation in question simply is not described in appellant's disclosure and in particular drawing Figures 5 and 6, as originally filed. In this regard, it is apparent from a cursory review of Figures 5 and 6 that the ends of the helical channel are not illustrated.

Appellant's argument on page 21 of the brief that a person skilled in the art would "most likely conclude, after reading applicant's specification and studying applicant's drawings, that applicant's embedded helical channel would inherently have closed ends" is speculative at best and clearly unsupported by any evidence in the record. Further, appellant's statement on page 22 of the brief that "the disclosure of a helical channel in itself is a disclosure of a helical channel with *either or both of its ends open or closed*" (emphasis added) undercuts appellant's position in that it supports the proposition that appellant's drawing figures do *not* amount to an inherent disclosure of a helical channel *with both ends closed*, as now claimed. See *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (inherency is not established by probabilities and possibilities) and *In re Winkhaus*, *supra* (that a particular structural configuration is *possible* in the practice of appellant's invention is not enough to establish descriptive support). Furthermore, the fact that it is of no particular significance to appellant whether the ends of the helical channel are open or closed (brief, page 22) is irrelevant to the issue at hand.

Appeal No. 1999-0117
Application 08/702,948

In conclusion, the examiner's rejection of claims 6 and 15 as being based on an original disclosure that fails to provide descriptive support is appropriate and will be sustained. Further, in that appellant has not separately argued the rejection of claims 7-14 apart from claims 6 and 15, the examiner's rejection thereof under 35 U.S.C. § 112, first paragraph, will also be sustained.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

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NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	
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Appeal No. 1999-0117
Application 08/702,948

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